

OFFICIAL

MONSANTO COMPANY
700 CHESTERFIELD PARKWAY NORTH
ST. LOUIS, MISSOURI 63198

#44
7-25-95

TELECOPIER NUMBER: (314) 537-6047**Date:** 7/18/95**FAX CENTER
RECEIVED****Fax:** (703) 308-4227**JUL 18 1995****Total Pages:**

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GROUP 1800

To: David T. Fox
U.S. Patent Office - Group 1814

From: Lawrence M. Lavin, Jr.
Patent Department
(314) 537-6670

Comments: Petition for Correction of Inventorship - U.S. 5,352,605**NOTICE OF CONFIDENTIAL INFORMATION**

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(314) 537-7446

PATENT
38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT OF)

Robert T. FRALEY et al.)

U.S. Patent No. 5,352,605)

Issued: October 4, 1994)

TITLE: CHIMERIC GENES FOR)
TRANSFORMING PLANT)
CELLS USING VIRAL)
PROMOTERS)

) GROUP ART UNIT: 184

) EXAMINER: David T. Fox

) July 18, 1995

I hereby certify that this correspondence is being facsimile
transmitted to the Patent and Trademark Office,
Washington D.C. on July 18, 1995
Lawrence M. Lavin, Jr.
Registration No. 39,768

Date: July 18, 1995

**PETITION FOR THE CORRECTION OF INVENTORSHIP
OF A PATENT UNDER 37 C.F.R. § 1.324**

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Patentees hereby petition under 37 C.F.R. § 1.324 to correct the inventorship of this patent to remove as an inventor Robert B. Horsch. Please charge deposit account 13-4125 for the petition fee set forth under 37 C.F.R. § 1.20(b). Enclosed with this petition is a copy of a statement of facts verified by the originally named inventors establishing when the error without deceptive intention was discovered and how it occurred, and a copy of a written consent of the assignee (see Exhibit 1).

Also enclosed is a new declaration executed by Stephen G. Rogers and Robert T. Fraley.

U.S. Patent No. 5,352,605
Petition to Correct Inventorship
Page 2

History of Inventorship Changes

During the prosecution of the above patent, patentees petitioned for the addition of Robert B. Horsch as an inventor. See Paper No. 33. A copy of these papers is attached as Exhibit 2. These papers include a declaration of the originally named inventors Robert T. Fraley and Stephen G. Rogers, showing that Robert B. Horsch was a co-inventor of then pending claims 16-18. This petition to add Robert B. Horsch as an inventor was granted, as indicated by the Office Action dated May 13, 1994 (Paper No. 39).

Subsequent to the grant of this petition, claims were canceled, including claims 16-18, which resulted in allowance of the patent application (Paper Nos. 40 and 41). The undersigned then submitted a petition under Rule 312(b) to remove Robert B. Horsch as an inventor because of the cancellation of claims. Attached as Exhibit 3 is a copy of the petition and a copy of the post card showing receipt of this petition by the U.S. Patent and Trademark Office on September 6, 1994. In response to a telephone request from Ex. David Fox, this petition was resubmitted on September 9, 1994 by facsimile. A copy of this resubmitted petition is enclosed as Exhibit 4. Neither petition has been acted upon by the Patent Office.

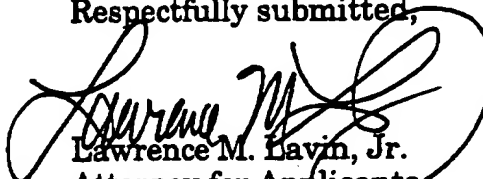
As set forth in petition under Rule 312(b), the cancellation of claims directed to Robert B. Horsch's contribution to the invention prior to the notice of allowance caused the amendment to the inventorship to be necessary. It was not until the preparation of a divisional application directed to Horsch's invention that the undersigned recognized the need for this amendment.

Since both a Rule 312(b) petition and the present petition have been

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Petition to Correct Inventorship
Page 3

submitted, applicants requests a refund of either the present petition fee under 37 C.F.R. § 1.20(b) or the prior fee charged under 37 C.F.R. § 1.17(i).

Respectfully submitted,



Lawrence M. Bayn, Jr.
Attorney for Applicants
Registration No. 30,768

Monsanto Company BB4F
700 Chesterfield Village Parkway
St. Louis, Missouri 63198
(314) 537-6670

U.S. Patent No. 5,352,605
Petition to Correct Inventorship
Page 4

EXHIBIT 1

PATENT
38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF)	
)	
Robert T. FRALEY et al.)	GROUP ART UNIT: 184
)	
SERIAL NO: 08/146,621)	EXAMINER: David T. Fox
)	
FILED: October 28, 1993)	
)	
NOW: U.S. Patent No. 5,352,605)	
)	
TITLE: CHIMERIC GENES FOR)	
TRANSFORMING PLANT)	
CELLS USING VIRAL)	
PROMOTERS)	

**DECLARATION OF ROBERT T. FRALEY, STEPHEN G. ROGERS
AND ROBERT B. HORSCH**

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

We, Robert T. Fraley, Stephen G. Rogers and Robert B. Horsch hereby declare as follows:

1. On January 17, 1983, three applications were filed, U.S. Serial No. 458,414 ("the '414 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; U.S. Serial No. 458,411 ("the '411 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; and U.S. Serial No. 458,402 ("the '402 application"), which listed as inventors Robert T. Fraley, Stephen G. Rogers and Robert B. Horsch. Each application incorporated the other application by reference. The '414 application originally claimed, *inter alia*, chimeric genes. The '411

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Declaration of Fraley, Rogers and Horsch
Page 2

application originally claimed, *inter alia*, a chimeric piece of DNA or a plasmid. The '402 application originally claimed, *inter alia*, a method of creating transformed plant cells and differentiated plants.

2. On April 15, 1983, U.S. Serial No. 458,568 ("the '568 application") was filed as a continuation-in-part application of the '414 application. This application incorporated the '414 application by reference. This application as originally filed contained a dependent claim directed to a differentiated plant.

3. On November 17, 1986, U.S. Serial No. 931,492 ("the '492 application") was filed as a continuation-in-part application of the '568 application. This application also incorporated the '568 application by reference. The '492 application as originally filed contained independent claims directed to differentiated plants.

4. On December 7, 1990, U.S. Serial No. 625,637 ("the '637 application") was filed as a file wrapper continuation of the '492 application. This application became involved in interference No. 102,890.

5. A continuation application of the '411 application was filed on October 4, 1985 (U.S. Serial No. 783,336) and a continuation application of the '402 application was filed on October 30, 1985 (U.S. Serial No. 793,486). The prosecution of both of these cases has been suspended pending a decision in Interference Nos. 102,924, 102,925 and 102,926.

U.S. Patent No. 5,352,605
Declaration of Fraley, Rogers and Horsch
Page 3

6. In reviewing the '637 application in preparation for the preliminary motion stage in the 102,890 interference, our attorney recognized that claims 10-18 did not correspond to the count (See Fraley's Motion No. 5). Moreover, it was recognized that claims 16-18, which are directed to differentiated plants, were invented by the same inventive entity as the '402 (and thus, the 793,486 application), i.e., Fraley, Rogers, and Horsch.

7. Fraley and Rogers are the inventors of chimeric genes containing either the 35S and 19S promoter, and are the inventors of plasmids containing these chimeric genes. Horsch's contribution was in selecting and regenerating differentiated plants containing the chimeric genes invented by Fraley and Rogers. The contribution of Horsch was always recognized by the fact that Horsch was listed as a joint inventor in the '402 application. This disclosure was incorporated by reference into the '414, '568, '492 and '637 applications, but it was not recognized by Fraley and Rogers that by introducing claims to differentiated plants containing chimeric genes in the '568, '492 and '637 applications that Horsch should also be listed as an inventor in these applications until Fraley and Rogers were informed of that fact by the attorney in preparation of the preliminary statements and motions in the 102,890 interference.

8. Fraley and Rogers reviewed the '568 and '492 applications and executed declarations for those applications in the belief that these applications claimed only

U.S. Patent No. 5,352,605
Declaration of Fraley, Rogers and Horsch
Page 4

Fraley and Rogers' contributions, and that Fraley and Rogers were the sole joint inventors. It was not until it was explained by the attorney in review of the application for the interference that Fraley and Rogers' mistake was recognized. This was the first time that it was recognized by Fraley and Rogers that by amending the claims to include differentiated plants that the claims then included the contribution of Horsch and that it was necessary to change the inventive entity.

9. Horsch was added to the application by the Examiner prior to issuance of the instant application. However, prior to issuance, the claims directed to differentiated plants were canceled. Therefore, Horsch again should have been removed as an inventor. The attorney requested this change before the patent issued, but this change did not occur.

U.S. Patent No. 5,352,605
Declaration of Fraley, Rogers and Horsch
Page 5

10. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

Date: 7/3/95

Robert T. Fraley
Robert T. Fraley

Date: June 26 1995

Stephen G. Rogers
Stephen G. Rogers

Date: 7/5/95

Robert B. Horsch
Robert B. Horsch

PATENT

38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF)

Robert T. FRALEY et al.)

U.S. Patent No. 5,352,605)

Issued: October 4, 1994)

TITLE: CHIMERIC GENES FOR)
TRANSFORMING PLANT)
CELLS USING VIRAL)
PROMOTERS)

) GROUP ART UNIT: 1804

) EXAMINER: David T. Fox

) July 18, 1995

I hereby certify that this correspondence is being facsimile
transmitted to the Patent and Trademark Office,
Washington D.C. on July 18, 1995Lawrence M. Levin, Jr. Registration No. 30,768Date: July 18, 1995**CONSENT OF ASSIGNEE**Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Monsanto Company is the assignee of the above referenced application, as demonstrated by the assignment recorded February 24, 1987 at Reel No. 4673, Frame No. 843. Monsanto Company consents to the change of inventorship in this patent from Robert T. Fraley, Robert B. Horsch and Stephen G. Rogers to Robert T. Fraley and Stephen G. Rogers.

Signed at St. Louis, State of Missouri, this 18th day of July, 1995.

MONSANTO COMPANY

By

Dennis R. Hoberner, Jr.
Dennis R. Hoberner, Jr.
Associate Patent CounselMonsanto Company
800 North Lindbergh
St. Louis, Missouri 63167

Attorney Docket No. 38-21(10640)A

Page 1

**SUBSTITUTE APPLICATION FOR UNITED STATES PATENT
DECLARATION * POWER OF ATTORNEY * PETITION**

AS A BELOW-NAMED INVENTOR, I hereby declare that:
MY RESIDENCE, citizenship, and post office address are as stated below,
next to my name.

I BELIEVE I am:

1. ☐ the original, first and sole inventor,
2. ☒ an original, first and joint inventor,

of the subject matter which is claimed and for which
a patent is sought on the invention entitled

3. **CHIMERIC GENES FOR TRANSFORMING PLANT CELLS USING
VIRAL PROMOTERS**

the specification of which, with any Preliminary Amendment,

4. ☐ is attached hereto
5. ☒ was filed on October 28, 1993
- 5(a). as application Serial No. 08/146,621
6. ☐ including Amendment(s) filed on _____ (date)
and _____ (date)
7. ☐ together with any Amendment(s) filed herewith.

I HEREBY STATE that I have reviewed and understand the contents of the
above-identified Specification, including the Claims, as amended by any Amendment(s)
referred to above.

I ACKNOWLEDGE my Duty to Disclose information of which I am aware
which is material to the Examination of this Application in accordance with Title 37, Code
of Federal Regulations, §1.56(a) including any such information which occurred between
the filing date of any prior application listed below for which the benefit of Title 35, United
States Code §120 is claimed and the filing date of this Application.

I HEREBY STATE that the subject matter which is claimed in any
Amendment(s) referred to above was part of my or our invention and was invented before
the filing of this Application.

BENEFIT OF EARLIER FILING DATE

THIS APPLICATION in whole or in part discloses and claims subject
matter disclosed in and I hereby claim the benefit under Title 35, United States Code,
§120 of any of my or our prior United States application(s) listed below:

Attorney Docket No. 38-21(10640)A

Page 2

	<u>SERIAL NO.</u>	<u>FILING DATE</u>	<u>STATUS</u>
8.	<u>458.414</u>	<u>Jan. 17. 1983</u>	<u>Abandoned</u>
	<u>458.568</u>	<u>Apr 15. 1983</u>	<u>Abandoned</u>
	<u>931.492</u>	<u>Nov. 17. 1986</u>	<u>Abandoned</u>

I HEREBY CLAIM foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or Inventor's Certificate(s) listed below:

	<u>NUMBER</u>	<u>COUNTRY</u>	<u>FILING DATE</u>
9.	_____	_____	_____

Any foreign application(s) for patent or Inventor's Certificate(s) filed by me or us which claims or discloses all or any part of the subject matter claimed in this Application and which has a filing date before that of the above-listed application(s) on which foreign priority is claimed is identified below:

	<u>NUMBER</u>	<u>COUNTRY</u>	<u>FILING DATE</u>
10.	_____	_____	_____

AS TO ANY subject matter which is claimed in this Application which is not common to any above-identified prior application(s) for which the benefit of 35 USC §119 or §120 is claimed, I do not know and do not believe that the same was ever known or used in the United States before my or our invention or discovery thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the date of this Application, or in public use or on sale in the United States more than one year prior to the date of this Application, that said subject matter has not been patented or made the subject of an Inventor's Certificate issued before the date of this Application in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months prior to this Application.

AS TO ANY subject matter which is claimed in this Application which is common to any above-identified prior application(s) for which the benefit of 35 USC §120 is claimed, I do not know and believe that the same was ever known or used in the United States before my or our invention or discovery thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the earliest of said prior application(s) to which said subject matter is common, or in public use or on sale in the United States more than one year prior to the earliest of said prior application(s) to which said subject matter is common, that said subject matter has not been patented or made the subject of an Inventor's Certificate issued before the date of the earliest of said prior application(s) to which said subject matter is common in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months prior to the earliest of said prior application(s) to which said subject matter is common.

Attorney Docket No. 38-21(10640)A

Page 3

11. ☐ ALL APPLICATION(S), if any, for patent or Inventor's Certificate on any part of said subject claimed in this Application filed by me or my representatives or assigns in any country foreign to the United States of America in addition to any listed above on which priority is claimed are listed in Annex A, attached hereto.

I HEREBY appoint the following as my attorney(s) and/or agent(s) of record with full power of substitution and revocation to prosecute this Application and to transact all business in the Patent and Trademark Office connected therewith.

12.	Lawrence M. Lavin, Jr.	Reg. No. 30,768
	Dennis R. Hoerner, Jr.	Reg. No. 30,914
	Richard H. Shear	Reg. No. 26,583
	James C. Bolding	Reg. No. 26,843

ALL correspondence/telephone calls in connection with this Application should be directed to:

13. Lawrence M. Lavin, Jr. - BB4F
MONSANTO COMPANY
700 Chesterfield Parkway North
St. Louis, MO 63198
13(a). Telephone Number: (314) 537-6670

I FURTHER declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Application or any patent issuing thereon.

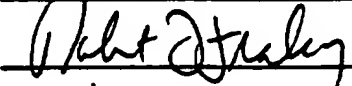
WHEREFORE, I PRAY that Letters Patent be granted to me solely or jointly with the additional inventor(s) (if any) named below for the invention described and claimed in the above-identified specification and claims, and I hereby subscribe my name to the above-identified specification and claims, Declaration, Power of Attorney and this Petition.

14(a). SOLE or FIRST JOINT INVENTOR,
full name: ROBERT THOMAS FRALEY

RESIDENCE (State/Country): Missouri/USA

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 1048 Woodfield Estates
Ballwin, Missouri 63011

INVENTOR'S SIGNATURE: 

DATE: 7/13/95

Attorney Docket No. 38-21(10640)A

Page 4

14(b). SECOND JOINT INVENTOR (if
any), full name:

STEPHEN GARY ROGERS

RESIDENCE (State/Country):

Missouri/USA

CITIZENSHIP:

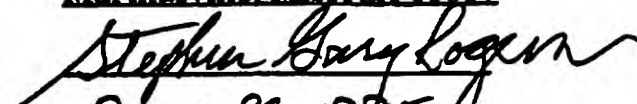
U.S.A.

POST OFFICE ADDRESS:

1344 Bernheimer Road
Marthasville, Missouri 63357

INVENTOR'S SIGNATURE:

DATE:


June 26 1985

14(c). THIRD JOINT INVENTOR (if
any), full name:

RESIDENCE (State/Country):

CITIZENSHIP:

POST OFFICE ADDRESS:

INVENTOR'S SIGNATURE:

DATE:

14(c). FOURTH JOINT INVENTOR (if
any), full name:

RESIDENCE (State/Country):

CITIZENSHIP:

POST OFFICE ADDRESS:

INVENTOR'S SIGNATURE:

DATE:

U.S. Patent No. 5,352,605
Petition to Correct Inventorship
Page 5

EXHIBIT 2

PATENT
38-21(10525)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 07/625,637

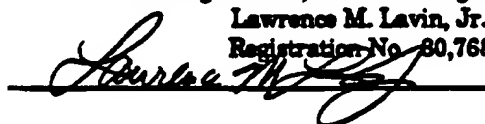
FILED: December 7, 1990

TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS

)
)
) GROUP ART UNIT: 184
)
) EXAMINER: David T. Fox
)
) August 21, 1992
)
)
)
)
)

I hereby certify that this correspondence is being
deposited with the United States Postal Service as
first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks,
Washington D.C., 20231 on August 21, 1992

Lawrence M. Lavin, Jr.
Registration No. 80,768

 Date: Aug 21, 1992

PETITION TO CORRECT INVENTORSHIP

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicants hereby petition under 37 C.F.R. 1.48 to correct the inventorship of this application. Accompanying this petition is a Declaration of Robert T. Fraley and Stephen G. Rogers setting forth the the facts establishing when the error in naming the incorrect inventorship occurred and how it occurred, showing that it occurred without deceptive intention. Also accompanying this petition are a declaration by each of the actual inventors under 37 C.F.R. 1.63 and a written consent of the assignee.

U.S. Serial No. 07/625,637
Petition to Correct Inventorship
Page 2

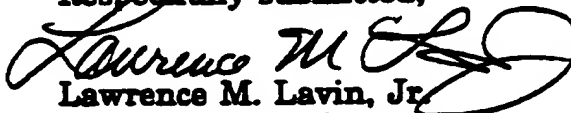
Correction of inventorship of an application should be granted as long as the error in naming the wrong inventorship occurred without any deceptive intention on the part of the actual inventors. 37 C.F.R. § 1.48(a). Indeed, if unclaimed subject matter is disclosed in an application that is invented by another, the application inventorship can be amended when the subject matter is claimed. 37 C.F.R. § 1.48(c). Here, the contribution of Horsch had always been disclosed in the parent and continuation applications, but was not claimed until the '568 application was filed. Applicants recognized the contribution of Horsch in view of the '402 application, which had claims directed to a method of producing differentiated plants and differentiated plants per se. Applicants did not recognize that by amending the claims to include claims to differentiated plants that the inventorship should also be amended until this was explained to applicants by their attorney in preparation for the preliminary statement and motions in Interference 102,890.

The error thus arose without any deceptive intent on the part of the actual inventors as required by Rule 48. It is therefore requested that this motion should be granted.

U.S. Serial No. 07/625,637
Petition to Correct Inventorship
Page 3

Please charge the fee set forth in 37 C.F.R. 1.17(h) to Deposit Account No. 13-4125. Please charge any additional fees associated with this petition or credit overpayment to the above-identified Deposit Account.

Respectfully submitted,


Lawrence M. Lavin, Jr.
Attorney for Applicants
Registration No. 30,768

Monsanto Company BB4F
700 Chesterfield Village Parkway
St. Louis, Missouri 63198
(314) 537-6670

PATENT
38-21(10525)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 07/625,637

FILED: December 7, 1990

TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS

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)
) GROUP ART UNIT: 184
)
) EXAMINER: David T. Fox
)
) August 21, 1992
)
)
)

I hereby certify that this correspondence is being
deposited with the United States Postal Service as
first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks,
Washington D.C., 20231 on August 21, 1992

Lawrence M. Lewis, Jr.
Registration No. 30,768

Lawrence M. Lewis, Jr. Date *Aug 21, 1992*

DECLARATION OF ROBERT T. FRALEY AND STEPHEN G. ROGERS

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

We, Robert T. Fraley and Stephen G. Rogers hereby declare as follows:

1. On January 17, 1983, three applications were filed, U.S. Serial No. 458,414 ("the '414 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; U.S. Serial No. 458,411 ("the '411 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; and U.S. Serial No. 458,402 ("the '402 application"), which listed as inventors Robert T. Fraley, Stephen G.

Serial No. 07/625,637
Declaration of Fraley and Rogers
Page 2

Rogers and Robert B. Horsch. Each application incorporated the other application by reference. The '414 application originally claimed, *inter alia*, chimeric genes. The '411 application originally claimed, *inter alia*, a chimeric piece of DNA or a plasmid. The '402 application originally claimed, *inter alia*, a method of creating transformed plant cells and differentiated plants.

2. On April 15, 1983, U.S. Serial No. 458,568 ("the '568 application") was filed as a continuation-in-part application of the '414 application. This application incorporated the '414 application by reference. This application as originally filed contained a dependent claim directed to a differentiated plant.

3. On November 17, 1986, U.S. Serial No. 931,492 ("the '492 application") was filed as a continuation-in-part application of the '568 application. This application also incorporated the '568 application by reference. The '492 application as originally filed contained independent claims directed to differentiated plants.

4. On December 7, 1990, U.S. Serial No. 625,637 ("the '637 application") was filed as a file wrapper continuation of the '492 application. This application is the application of party Fraley et al. which is subject to the present interference.

5. A continuation application of the '411 application was filed on October 4, 1985 (U.S. Serial No. 783,336) and a continuation application of the '402

Serial No. 07/625,637
Declaration of Fraley and Rogers
Page 3

application was filed on October 30, 1985 (U.S. Serial No. 793,486). The prosecution of both of these cases has been suspended pending the declaration of one or more interferences.

6. In reviewing the '637 application in preparation for the preliminary motion stage of the present interference, our attorney recognized that claims 10-18 did not correspond to the count (See Fraley's Motion No. 5). Moreover, it was recognized that claims 16-18, which are directed to differentiated plants, were invented by the same inventive entity as the '402 (and thus, the 793,486 application), i.e., Fraley, Rogers, and Horsch.

7. We are the inventors of chimeric genes containing either the 35S and 19S promoter, and are the inventors of plasmids containing these chimeric genes. Horsch's contribution was in selecting and regenerating differentiated plants containing the chimeric genes invented by us. The contribution of Horsch was always recognized by the fact that Horsch was listed as a joint inventor in the '402 application. This disclosure was incorporated by reference into the '414, '568, '492 and '637 applications, but it was not recognized by us that by introducing claims to differentiated plants containing chimeric genes in the '568, '492 and '637 applications that Horsch should also be listed as an inventor in these applications until we were informed of that fact by our attorney in preparation of the preliminary statements and motions in the present interference.

Serial No. 07/625,637
Declaration of Fraley and Rogers
Page 4

8. We reviewed the '568 and '492 applications and executed declarations for those applications in the belief that these applications claimed only our contributions, and that we were the sole joint inventors. It was not until it was explained by our attorney in review of the application for the interference that our mistake was recognized by us. This was the first time that it was recognized by us that by amending the claims to include differentiated plants that the claims then included the contribution of Horsch and that it was necessary to change the inventive entity.

9. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

Date:

Aug 20, 1992
Robert T. Fraley

Date:

Aug 19 1992
Stephen G. Rogers

PATENT
38-21(10525)A

SUBSTITUTE APPLICATION FOR UNITED STATES PATENT
DECLARATION • POWER OF ATTORNEY • PETITION

AS A BELOW-NAMED INVENTOR, I hereby declare that:

MY RESIDENCE, citizenship, and post office address are as stated below, next to my name.

I BELIEVE I am:

1. ☐ The original, first and sole inventor,
2. ☒ an original, first and joint inventor,

of the subject matter which is claimed and for which a patent is sought on the invention entitled:

3. **CHIMERIC GENES FOR TRANSFORMING PLANT CELLS USING VIRAL PROMOTERS**

the specification of which, with any Preliminary Amendments,

4. ☐ is attached hereto
5. ☒ was filed on December 7, 1990
- 5(a) as Application Serial No. 07/625,637
6. ☐ including Amendment(s) filed on
7. ☐ together with any Amendment(s) filed herewith.

I HEREBY STATE that I have reviewed and understand the contents of the above-identified specifications, including the Claims, as amended by any Amendment(s) referred to above.

I ACKNOWLEDGE my Duty to Disclose information of which I am aware which is material to the Examination of this Application in accordance with Title 37, Code of Federal Regulations, §1.56(a) including any such information which occurred between the filing date of any prior application listed below for which the benefit of Title 35, United States Code §120 is claimed and the filing date of this Application.

I HEREBY STATE that the subject matter which is claimed in any Amendment(s) referred to above was part of my or our invention and was invented before the filing of this Application.

Page 2

BENEFIT OF EARLIER FILING DATE

THIS APPLICATION in whole or in part discloses and claims subject matter disclosed in and I hereby claim the benefit under title 35, United States Code, §120 of any of my or our prior United States Applications(s) listed below:

	<u>SERIAL NO.</u>	<u>FILING DATE</u>	<u>STATUS</u>
8.	458,414	January 17, 1983	Abandoned
	458,568	April 15, 1983	Abandoned
	931,492	November 17, 1986	Abandoned

I HEREBY CLAIM foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or Inventor's Certificate(s) listed below:

	<u>NUMBER</u>	<u>COUNTRY</u>	<u>FILING DATE</u>
9.			

Any foreign application(s) for patent or Inventor's Certificate(s) filed by me or us which claims or discloses all or any part of the subject matter claimed in this Application and which has a filing date before that of the above-listed application(s) on which foreign priority is claimed is identified below:

	<u>NUMBER</u>	<u>COUNTRY</u>	<u>FILING DATE</u>
10.			

AS TO ANY subject matter which is claimed in this Application which is not common to any above-identified prior application(s) for which the benefit of 35 U.S.C. §119 or §120 is claimed, I do not know and do not believe that the same was ever known or used in the United States before my or our invention or discovery thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the date of this Application, or in public use or on sale in the United States more than one year prior to the date of this Application, that said subject matter has not been patented or made the subject of an Inventor's Certificate issued before the date of this Application filed by me or my legal representatives or assigns more than twelve months prior to this Application.

AS TO ANY subject matter which is claimed in this Application which is common to any above-identified prior applications(s) for which the benefit of 35 U.S.C. §120 is claimed, I do not know and believe that the same was ever known or used in the United States before my or our invention or discovery thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the earliest of said prior application(s) to which said subject matter is common, or in public use or on sale in the United States more than one year prior to the earliest of said prior application(s) to which said subject matter is common, that said subject matter has not been patented or made the subject of an Inventor's Certificate issued before the date of the earliest of

Page 3

said prior application(s) to which said subject matter is common in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months prior to the earliest of said prior applications(s) to which said subject matter is common.

11. ☐ ALL APPLICATION(S), if any, for patent or Inventor's Certificate on any part of said subject claimed in this Application filed by me or my representatives or assigns in any country foreign to the United States of America in addition to any listed above on which priority is claimed are listed in Annex A, attached hereto.

I HEREBY appoint the following as my attorney(s) and/or agent(s) of record with full power of substitution and revocation to prosecute this Application and to transact all business in the Patent and Trademark Office connected therewith.

- | | | |
|-----|------------------------|-----------------|
| 12. | Lawrence M. Lavin, Jr. | Reg. No. 30,768 |
| | Dennis R. Hoerner, Jr. | Reg. No. 30,914 |
| | James C. Bolding | Reg. No. 26,843 |

ALL correspondence/telephone calls in connection with this Application should be directed to:

13. Lawrence M. Lavin, Jr.
Monsanto Company - BB4F
700 Chesterfield Village Parkway
St. Louis, Missouri 63198

- 13(a). Telephone Number: (314) 537-6670

I FURTHER declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Application or any patent issuing thereon.

WHEREFORE, I PRAY that Letters Patent be granted to me solely or jointly with the additional inventor(s) (if any) named below for the invention described and claimed in the above-identified specification and claims, and I hereby subscribe my name to the above-identified specification and claims, Declaration, Power of Attorney and this Petition.

Page 4

14(a). **SOLE or FIRST JOINT INVENTOR,**
first name: ROBERT THOMAS FRALEY

RESIDENCE (State/Country) Missouri / U.S.A.

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 1048 Woodfield Estates
Ballwin, Missouri 63014

INVENTOR'S SIGNATURE *Robert T. Fraley*

DATE: Aug 20, 1992

14(b). **SECOND JOINT INVENTOR,**
(if any) full name: ROBERT BRUCE HORSCH

RESIDENCE (State/Country) Missouri / U.S.A.

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 12768 Whispering Hills Lane
St. Louis, Missouri 63146

INVENTOR'S SIGNATURE *Robert Bruce Horsch*

DATE: August 20, 1992

14(c). **THIRD JOINT INVENTOR,**
(if any) full name: STEPHEN GARY ROGERS

RESIDENCE (State/Country) Missouri / U.S.A.

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 4235 West Pine Boulevard #2
St. Louis, Missouri 63108

INVENTOR'S SIGNATURE *Stephen G. Rogers*

DATE: August 19 1992

14(d). **FOURTH JOINT INVENTOR,**
(if any) full name:

RESIDENCE (State/Country)

CITIZENSHIP:

POST OFFICE ADDRESS:

INVENTOR'S SIGNATURE _____

DATE: _____

PATENT
38-21(10525)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 07/625,637

FILED: December 7, 1990


TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS

)
)
) GROUP ART UNIT: 184
)
) EXAMINER: David T. Fox
)
) August 21, 1992
)
)
)
)

I hereby certify that this correspondence is being deposited with the United States
Postal Service as first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks,
Washington D.C., 20231 on August 21, 1992

Lawrence M. Levin, Jr.

Registration No. 30,768

 Date Aug 21, 1992

CONSENT OF ASSIGNEE

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Monsanto Company is the assignee of the above referenced application, as demonstrated by the assignment recorded February 24, 1987 at Reel No. 4673, Frame No. 843. Monsanto Company consents to the change of inventorship in this application from Robert T. Fraley and Stephen G. Rogers to Robert T. Fraley, Robert B. Horsch and Stephen G. Rogers.

Signed at St. Louis, State of Missouri, this 20th day of August, 1992.

MONSANTO COMPANY

By


Dennis R Hoerner
Associate Patent Counsel

Monsanto Company
800 North Lindbergh
St. Louis, Missouri 63167

U.S. Patent No. 5,352,605
Petition to Correct Inventorship
Page 4

EXHIBIT 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) Fraley et al. CASE: 38-21(10640)A
ATTY: LML

TITLE Chimeric genes for transforming plant cells using viral
Description of Paper promoters

Petition for Amendment, petition to correct inventorship.

Pages of Spec. ()

Number of Claims

Sheets of Dwg.

PATENT OFFICE

DATE STAMP BELOW



Declaration ()

Deposit Acct. No. 13-415

Date Mailed to PTO 9-2-94

Serial No. 08/146,621

G-4526 (Rev. 2/94)

Action Date	_____
Attorney	<u>WJ</u>

js
9/12/94

PATENT
38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF)

Robert T. FRALEY et al.)

SERIAL NO: 08/146,621)

FILED: October 28, 1993)

TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS)

) GROUP ART UNIT: 184

) EXAMINER: David T. Fox

) September 2, 1994

) Batch B84

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deposited with the United States Postal Service as
first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks,
Washington D.C., 20231 on September 2, 1994

Lawrence M. Lavin, Jr.
Registration No. 30,768

Date:

9/2/94

PETITION FOR AN AMENDMENT UNDER RULE 312(b)

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

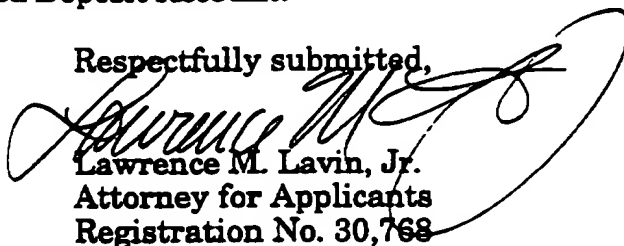
Applicants hereby petition to amend the application under 37 C.F.R. §§
1.312(b) and 1.48(b) to correct the inventorship of this application to remove as an
inventor Robert B. Horsch. The cancellation of claims directed to this inventor's
invention prior to the notice of allowance caused this amendment to be necessary.
These claims were cancelled in an amendment filed June 1, 1994. The notice of
allowance was mailed June 20, 1994 and the issue fee was paid on June 27, 1994, in
an effort to get early issuance of a patent application that had been pending over ten

U.S. Serial No. 08/146,621
PETITION FOR AN AMENDMENT UNDER RULE 312(b)
Page 2

years. It was not until the preparation of a divisional application directed to this inventor's invention, which is being filed on this date, that the undersigned recognized the need for this amendment.

Please charge the fee set forth in 37 C.F.R. 1.17(i) to Deposit Account No. 13-4125. Please charge any additional fees associated with this petition or credit overpayment to the above-identified Deposit Account.

Respectfully submitted,



Lawrence M. Lavin, Jr.
Attorney for Applicants
Registration No. 30,768

Monsanto Company BB4F
700 Chesterfield Village Parkway
St. Louis, Missouri 63198
(314) 537-6670

PATENT
38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 08/146,621

FILED: October 28, 1993

TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS

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)
) GROUP ART UNIT: 184
)
) EXAMINER: David T. Fox
)
) September 2, 1994
)
)
) Box B84
)
)

I hereby certify that this correspondence is being
deposited with the United States Postal Service as
first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks,
Washington D.C., 20231 on September 2, 1994
Lawrence M. Lavin Jr.
Registration No. 30,768

Date: 9/2/94

PETITION TO CORRECT INVENTORSHIP

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

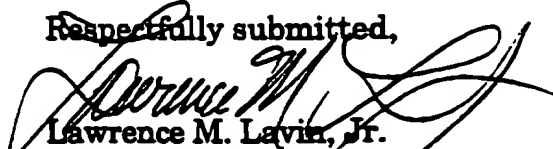
Applicants hereby petition under 37 C.F.R. 1.48(b) to correct the inventorship of this application to remove as an inventor Robert B. Horsch. The cancellation of claims directed to this inventor's invention prior to the notice of allowance caused this amendment to be necessary. It was not until the preparation of a divisional application directed to this inventor's invention, which is being filed on this date, that the undersigned recognized the need for this amendment.

Please charge the fee set forth in 37 C.F.R. 1.17(h) to Deposit Account No.

U.S. Serial No. 08/146,621
Petition to Correct Inventorship
Page 2

13-4125. Please charge any additional fees associated with this petition or credit overpayment to the above-identified Deposit Account.

Respectfully submitted,



Lawrence M. Lavin, Jr.
Attorney for Applicants
Registration No. 30,768

Monsanto Company BB4F
700 Chesterfield Village Parkway
St. Louis, Missouri 63198
(314) 537-6670

U.S. Patent No. 5,352,605
Petition to Correct Inventorship
Page 1

EXHIBIT 4

MONSANTO COMPANY
700 CHESTERFIELD PARKWAY NORTH
ST. LOUIS, MISSOURI 63198

TELECOPIER NUMBER: (314) 537-6047

DATE: September 9, 1994

FAX: (703) 305-3014

TOTAL # PAGES: 5

TO: Ex. David T. Fox

U.S. Patent Office - Group 1804

FROM: Lawrence M. Lavin, Jr.
Patent Department
(314) 537-6670

COMMENTS: Enclosed are a Petition for an amendment under 37 C.F.R. § 1.312(b) and a Petition to Correct Inventorship under 37 C.F.R. § 1.48(b).

NOTICE OF CONFIDENTIAL INFORMATION

The information contained in this facsimile message is **CONFIDENTIAL INFORMATION** and may also be **LEGALLY PRIVILEGED**, intended only for the use of the individual or entity named above. If you are not the intended recipient, you are hereby notified that any use, review, dissemination, distribution or copying of this document is strictly prohibited. If you have received this document in error, please immediately notify us by telephone (call collect to the person and number below) and destroy the original message. Thank you.

If all pages are not received, or if copies are illegible, please contact Waraporn Wun at (314) 537-7446

PATENT
38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 08/146,621

FILED: October 28, 1993

TITLE: CHIMERIC GENES FOR
TRANSFORMING PLANT
CELLS USING VIRAL
PROMOTERS

)
)
) GROUP ART UNIT: 184
)
) EXAMINER: David T. Fox
)
) September 9, 1994
)
) Batch B84
)
)

I hereby certify that this correspondence is being facsimile
transmitted to the Patent and Trademark Office,
Washington D.C. on September 9, 1994

Lawrence M. Lavin, Jr.
Registration No. 30,768

Date:

9/9/94

PETITION FOR AN AMENDMENT UNDER RULE 312(b)

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicants hereby petition to amend the application under 37 C.F.R. §§
1.312(b) and 1.48(b) to correct the inventorship of this application to remove as an
inventor Robert B. Horsch. The cancellation of claims directed to this inventor's
invention prior to the notice of allowance caused this amendment to be necessary.
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an effort to get early issuance of a patent application that had been pending over ten
years. It was not until the preparation of a divisional application directed to this

U.S. Serial No. 08/146,621

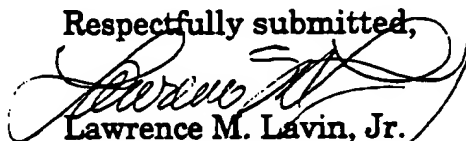
PETITION FOR AN AMENDMENT UNDER RULE 312(b)

Page 2

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Please charge the fee set forth in 37 C.F.R. 1.17(i) to Deposit Account No. 13-4125. Please charge any additional fees associated with this petition or credit overpayment to the above-identified Deposit Account.

Respectfully submitted,



Lawrence M. Lavin, Jr.
Attorney for Applicants
Registration No. 30,768

Monsanto Company BB4F
700 Chesterfield Village Parkway
St. Louis, Missouri 63198
(314) 537-6670

PATENT
38-21(10640)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Robert T. FRALEY et al.

SERIAL NO: 08/146,621

FILED: October 28, 1993

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) EXAMINER: David T. Fox
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) September 9, 1994
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I hereby certify that this correspondence is being facsimile
transmitted to the Patent and Trademark Office,
Washington D.C. on September 9, 1994

Lawrence M. Lavin, Jr.
Registration No. 30,768

Date:

9/9/94

PETITION TO CORRECT INVENTORSHIP

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicants hereby petition under 37 C.F.R. 1.48(b) to correct the inventorship of this application to remove as an inventor Robert B. Horsch. The cancellation of claims directed to this inventor's invention prior to the notice of allowance caused this amendment to be necessary. It was not until the preparation of a divisional application directed to this inventor's invention, which was filed on September 2, 1994, that the undersigned recognized the need for this amendment.

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U.S. Serial No. 07/625,637
Petition to Correct Inventorship
Page 2

overpayment to the above-identified Deposit Account.

Respectfully submitted,



Lawrence M. Lavin, Jr.
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700 Chesterfield Village Parkway
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(314) 537-6670